

AMENDMENTS TO THE DRAWINGS

Attached hereto is one (1) sheet of correct formal drawings that comply with the provisions of 37 C.F.R. § 1.84.

It is respectfully requested that the corrected formal drawings be approved and made a part of the record of the above-identified application.

R E M A R K S

Claims 1-45, 58-73, 75 and 76 are pending in this application. No new matter has been added by way of the present amendments. For instance, the recitation of "adhesion layer" has been replaced with the capitalized version of "Adhesion Layer" in claim 1, item (iii). Additionally, claim 74 has been cancelled. Accordingly, no new matter has been added.

Additionally, Applicants submit that no new issues have been raised by way of the present submission that would require additional search and/or consideration on the part of the Examiner. For instance, claim 1 has been amended to adopt a suggested change made by the Examiner and to remove an objection. Additionally, claim 74 has been cancelled, thus removing an issue. Accordingly, entry of the above amendments would not require additional search and/or consideration on the part of the Examiner. Thus, no "new issues" have been raised.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Objection to the Drawings

The Examiner has objected to the drawings requesting that formal drawings be supplied. Attached hereto, Applicants provide a

formal version of Figure 1. Entry on the record is respectfully requested.

Objections to the Claims

The Examiner has objected to claim 1 for the recitation of "adhesion layer" in line 6 of item (iii). The Examiner has requested that this be replaced with "Adhesion Layer" so as to be consistent with its antecedent basis. Applicants submit that this suggested amendment has been adopted in the present reply. This clearly a non-narrowing amendment. Thus, this objection is moot. Reconsideration and withdrawal thereof are respectfully requested.

Issues under 35 U.S.C. 112, first paragraph

The Examiner has rejected claim 74 under 35 U.S.C. 112, first paragraph asserting that it fails to comply with the written description requirement. In particular, the Examiner asserts that the phrase "no adhesion layer" is "new matter". Applicants respectfully traverse. Also, Applicants submit that there is no analogy with the rule of *Ex Parte Grasselli et al.* - Bd. of App. 231 PQ 393, Affd. 738 F.2d 453 (Fed. Cir. 1984). The *Ex Parte Grasselli* renders no discussion of the element, which the claim was "free of". Rather, in the present application, the adhesion layer is discussed "frequently". Moreover, the examples, Figure 1 and the description at page 40, line 29 to page 49, line 12, clearly

indicate that no adhesion layer is applied over the image-receiving layer. While it may be true, it is not specifically cited that the adhesion layer is absent, it is clear that no adhesion layer is added. Thus, this claim does not constitute new matter. However, in order to expedite prosecution, Applicants have cancelled this claim. It does not constitute a narrowing amendment with respect to the scope of claim 1, upon which claim 74 depends. Claim 1 encompasses the presence or absence of additional layers on top of the image-receiving layer rendering claim 74 entirely unnecessary and redundant.

Accordingly, this rejection is moot. Reconsideration and withdrawal thereof are respectfully requested.

Citation of Copending U.S. Application No. 09/824,134, published as U.S. 2001/0051265

The Examiner has noted at item 9 at page 4 of the outstanding Office Action that U.S. Application 09/824,134 published as U.S. 2001/0051265 has been allowed and claims methods of making the heat setting labels of the instantly claimed invention. Applicants acknowledge this fact, however, submit that it does not affect the patentability of the present application. First, the cited application is not prior art. Second, there is no issue with respect to obviousness-type double patenting, since the presently claimed products restricted from the methods as outlined in the

February 14, 2002 Office Action. Thus, no action concerning this issue is required.

Allowable Subject Matter

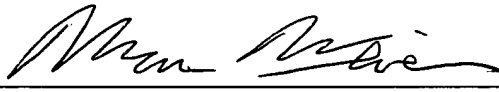
The Examiner indicated at page 3 of the outstanding Office Action, that claims 1-45, 58-73, 75 and 76 are allowable. Applicants submit that these are the only pending claims and the objection to claim 1 has been overcome. Thus, all currently pending claims are in condition for allowance. Reconsideration and withdrawal of all outstanding rejections is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig A. McRobbie (Reg. No. 42,874) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

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MSW/CAM:bmp
0175-0284P
Attachment

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